

REMARKS

I. Introduction

Claims 19, 21, 22, 24-27 and 30-36 are currently pending in the present application. Applicants have amended claims 19 and 27. In view of the following remarks, it is respectfully submitted that all pending claims are allowable, and reconsideration of these claims is respectfully requested.

II. Rejection of Claims 19, 21, 22, 27, 30-32, 35 and 36 under 35 U.S.C § 102(e)

Claims 19, 21, 22, 27, 30-32, 35 and 36 are rejected under 35 U.S.C § 102(e) as being anticipated by Kotre (U.S. Patent 6,664,651). Applicants respectfully submit that the rejection should be withdrawn for the following reasons.

In order to reject a claim under 35 U.S.C. § 102(e), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. See Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter of the claims. See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). To the extent that the Examiner may be relying on the doctrine of inherent disclosure, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'l. 1990). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherence of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

Claims 19 and 27 have been amended to clarify the meaning of “power demands of an electrical system,” i.e., amended claim 19 recites “means for determining overall power demands of an electrical system of the motor vehicle during idling, wherein the electrical

system of the motor vehicle includes all electrically operated units of the motor vehicle,” and amended claim 27 similarly recites that “the internal combustion engine is controlled in one of open and closed loop as a function of overall power demands of an electrical system of the motor vehicle . . . , wherein the electrical system of the motor vehicle includes all electrically operated units of the motor vehicle.” These amended features are explicitly described in the original Specification, p. 6, l. 27 – p. 7, l. 1 and p. 7, l. 29 – p. 8, l. 2 (corresponding to Substitute Specification, p. 6, l. 12-18 and p. 7, l. 14-22).

First, to the extent the Examiner cites col. 4, l. 20-37 and col. 6, l. 26-43 of Kotre as teaching “means for determining power demands of an electrical system of the motor vehicle during idling,” the cited disclosure clearly fails to suggest the present claimed invention. For example, col. 4, l. 20-37 of Kotre merely disclose determining whether battery is too low, by comparing to a predetermined minimum value. In addition, col. 6, l. 26-43 merely indicate: (a) determining whether air conditioning has been requested, (b) keeping the engine on idle speed until air conditioning panel is switched off, and (c) charging the batter 36 at a rate dictated by the amount of engine brake torque requested. There is simply no suggestion in Kotre regarding the claimed limitation of “determining overall power demands of an electrical system of the motor vehicle during idling, wherein the electrical system of the motor vehicle includes all electrically operated units of the motor vehicle.”

Second, to the extent the Examiner cites col. 6, l. 32-43 of Kotre as teaching “converting the power demands of the electrical system of the motor vehicle during idling into a setpoint torque of the internal combustion engine,” the cited section merely indicates that to “accomplish this [keeping the engine at idle speed until an air conditioning panel is switched off], the desired engine torque is scheduled that will minimize fuel consumption while accommodating this request.” There is no suggestion in Kotre regarding the claimed limitation of “a pre-control unit for **converting the overall power demands of the electrical system of the motor vehicle during idling into a setpoint torque** of the internal combustion engine.”

Third, there is no disclosure in Kotre which supports the Examiner’s contention that Kotre discloses “during idling, the engine management system (46) controls the engine (24)

in one of open and closed loop as a function of the power demands of the electrical system of the motor vehicle,” let alone any disclosure suggesting control of “the internal combustion engine in one of open and closed loop as a function of the **overall power demands** of the electrical system of the motor vehicle.” In this regard, Applicants note that the Examiner has not even attempted to cite any portion of Kotre in support of the Examiner’s contention. To the extent the Examiner is implicitly contending that the claimed feature is inherently disclosed by Kotre, there is simply no “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics **necessarily flow** from the teachings of the applied art.”

Forth, there is no disclosure in Kotre which supports the Examiner’s contention that Kotre discloses “wherein during idling the engine (24) is speed-controlled with the aid of the electric machine (30).” In this regard, Applicants note that the Examiner has not even attempted to cite any portion of Kotre in support of the Examiner’s contention. To the extent the Examiner is implicitly contending that the claimed feature is inherently disclosed by Kotre, there is simply no “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics **necessarily flow** from the teachings of the applied art.”

Fifth, to the extent the Examiner cites col. 5, l. 55-60 of Kotre as disclosing that “a power output of the engine (24) is adjusted to an instantaneous power demand of the electrical system of the motor vehicle,” the cited section merely discloses that “[i]f air conditioning . . . is requested, the amount of engine torque requested will be modified slightly to accommodate the request.” There is no suggestion in Kotre that “a power output of the internal combustion engine is adjusted to an instantaneous **overall power demand** of the electrical system of the motor vehicle.”

Sixth, there is no suggestion in Kotre that “the setpoint torque of the internal combustion engine is determined as a function of the instantaneous **overall** power demand of the electrical system of the motor vehicle,” and the Examiner has not even attempted to cite any portion of Kotre in support of the Examiner’s contention. To the extent the Examiner is implicitly contending that the claimed feature is inherently disclosed by Kotre, there is simply

no “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.”

Seventh, to the extent the Examiner has cited col. 7, l. 6-11 of Kotre as disclosing the claimed feature that “at least one of an injection quantity, an air quantity, and an ignition angle of the internal combustion engine is adjusted according to the determined setpoint torque,” the cited section merely indicates that in the “secondary engine idle mode” the engine idle speed is controlled via control of fuel, airflow, and ignition timing, but there is no suggestion that injection quantity, an air quantity, and/or an ignition angle is adjusted according to the setpoint torque determined as a function of the instantaneous overall power demand of the electrical system of the motor vehicle. To the extent the Examiner is implicitly contending that the claimed feature is inherently disclosed by Kotre, there is simply no “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.”

For the foregoing reasons, claims 19 and 27, as well as dependent claims 21, 22, 30-32, 35 and 36, are allowable over Kotre.

III. Rejection of Claims 24-26, 33 and 34 under 35 U.S.C § 103(a)

Claims 24-26, 33 and 34 are rejected under 35 U.S.C § 103(a) as being obvious over Kotre in view of Tokushima (U.S. Patent 5,690, 580). Applicants respectfully submit that the rejection should be withdrawn for the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. In addition, as clearly indicated by the Supreme Court, it is “important to identify a reason that would have

prompted a person of ordinary skill in the relevant field to [modify] the [prior art] elements” in the manner claimed. See KSR Int’l Co. v. Teleflex, Inc., 82 U.S.P.Q.2d 1385 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Id., at 1396.

Claims 24-26, 33 and 34 ultimately depend on claim 19 or claim 27. As noted above, amended claims 19 and 27 are clearly allowable over Kotre. In addition, the secondary Tokushima reference does not remedy the deficiencies of Kotre as applied against parent claims 19 and 27. Therefore, the overall teachings of Kotre and Tokushima cannot render dependent claims 24-26, 33 and 34 obvious.

For at least the foregoing reasons, dependent claims 24-26, 33 and 34 are allowable over Kotre and Tokushima.

IV. Conclusion

In view of all of the above, it is respectfully submitted that all of the presently pending claims are in allowable condition. Prompt reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,

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